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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,902	11/02/1999	KAZUYUKI OHTSU	FUJY=16.705	9388

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EXAMINER

FERRIS, DERRICK W

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/431,902

Applicant(s)

OHTSU ET AL.

Examiner

Derrick W. Ferris

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. **Claims 1-8** as amended are still in consideration for this application. Applicant has amended claims 1, 2, 3, 4, 7, and 8.
2. Examiner **withdraws** the obviousness rejection to *Vargo* for Office action filed 12/18/02 in reference to line item 2-3. Examiner notes the rejection still stands, however, the examiner has added a further reference to add further support for the claims as necessitated by amendment.

Applicant has amended the claims to further recite and clarify a “pass-through” state by reciting a further clarifying step of a judging section. Examiner notes that a judging section is either inherent or obvious in view of the teachings of *Vargo* (and *Haeggstrom*). In short, applicant’s judging/control section performs no action if the compression form judged is the same (i.e., data is passed through the gateway if compression is already detected) and performs an action if the compression form judged is different (i.e., a predetermined compression is applied based on gateway settings if no compression is detected). *Vargo* discloses setting the codec based on network properties [column 7, lines 18-27]. Specifically, if the gateway is acting as a transmitter (i.e., no codec is detected) then the codec is selected from a “complex function of choices of packet redundancy, packet size, and packet bundling” and if the gateway is acting as a receiver (i.e., a codec is detected) then the gateway is “given self-describing information about what type of codec is needed”. Thus examiner notes that *Vargo* implicitly teaches that each packet is first checked to see if a codec method has been applied and if a codec method is applied then the method is read from the “self-describing” means (i.e., passed-through). Otherwise, examiner notes a new codec method is applied based on the “complex function” (i.e., since no

compression method has been previously applied). Should the interpretation be improper from the *Vargo* reference alone (i.e., a pass-through state is not clearly taught), examiner notes further support taught from U.S. Patent No. 6,167,040 to *Haeggstrom* (previous 892 form) which teaches in a second embodiment (figure 4) that tandem free operation (TFO) is possible between a telephone on a PSTN network connected via an IP/PSTN gateway to the Internet [column 6, lines 8-67; column 7, lines 1-25 with emphasis column 6, lines 9-14 and column 7, lines 10-11]. Specifically taught by *Haeggstrom* is transporting TFO frames into IP packets, and IP packets into TFO frames where the path from PSTN telephone to the Internet is tandem free in either direction (i.e., by definition the codecs are the same throughout the call). Specifically that TFO extends further into the Internet network [column 6, lines 8-14]. Recall that *Vargo* teaches (and that is well known in the art) that codecs must be the same in order for both parties to understand one another [column 2, lines 20-22]. Thus if the codec used in the TFO PSTN network is the same as the codec used for the IP terminal then the codec used in the gateway must be the same as the codec in the TFO PSTN network and the IP terminal (i.e., by definition a pass through is taught otherwise the call could not be understood since the codecs are not the same throughout the call). In the case of going from PSTN-to-IP where a codec is not detected (e.g., since compression has not taken place yet) then the gateway will perform compression based on a “complex function” (as taught by *Vargo*). Thus the combined teachings provide a motivation for the concept behind a “judging section” in general.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,356,545 to *Vargo et al.* ("*Vargo*") in view of U.S. Patent No. 6,167,040 to *Haeggstrom*.

As to **claims 1, 2, 7 and 8**, *Vargo* discloses an Internet system able to dynamically select a CODEC (i.e., perform expansion and compression using a broad but reasonable interpretation of the term CODEC) [Abstract]. Specifically, *Vargo* discloses an invention relating generally to both the Internet and the PSTN (i.e., circuit switched networks) thus creating a motivation as a whole for applying this reference [column 1, lines 15-20]. *Vargo* presents a gateway 10 for voice communications between an Internet Protocol (IP) network 17 and a circuit switched network 11 [figure 1; column 3, lines 42-56; column 4, lines 36-40]. This gateway uses software to create a session (figure 4) and control the characteristics of a session at a voice port by not only adjusting such factors as the packet size or bundling of a packet [column 7, lines 6-17] but also varying in the selection of a codec per packet as well [column 7, lines 18-27]. Thus examiner notes a broad but reasonable teaching of either expansion or compression depending on the type of codec employed per packet. Thus examiner notes that should no codec be employed per packet then a tandem free operation (TFO) is broadly performed in that the software (i.e. controller) of the gateway can transmit the packets without subject to expansion/compression using a broad but reasonable interpretation of the recited claimed subject matter.

Examiner notes the reference also indirectly teaches a setting section using a broad but reasonable interpretation of the claim. Examiner notes specifically that *Vargo* teaches selecting a codec 222 based on speech quality 221 at a voice port 61 (figure 11(b)) where it would have been either inherent or obvious to a skilled artisan prior to applicant's invention that the codec selected (i.e., the judging section with controller) is based on a pass-through state if compression has already taken place on the transmitting side. The motivation for a pass-through state comes from an end-to-end tandem free operation as is known in the art. *Haeggstrom* provides additional support for end-to-end tandem free operation using the same codec end-to-end such that the codec in the gateway must be the same which is taught in the second embodiment shown in figure 4.

As to **claim 3**, in addition to the reasoning mentioned in claim 3, shown in figure 1 are multiple gateways connecting a circuit switched network (i.e., the PSTN) to an Internet Protocol (IP) network (i.e., the INET 17). Noted previously by the reference the software of the gateway is used to control the session information for the call including the port characteristics for the session.

As to **claims 4, 5 and 6**, examiner acknowledges that *Vargo* teaches codec selection in general for each gateway. Also taught could be not selecting a codec thus performing a Tandem Free Operation as is well known in the art to a skilled artisan prior to applicant's invention. Also taught by *Vargo* is selecting a codec based on speech quality should a codec not be detected.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

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DWF 
June 20, 2003

Derrick W. Ferris
Examiner
Art Unit 2663



MELVIN MARCELO
PRIMARY EXAMINER